

REMARKS

A. 35 U.S.C. § 103

1. Bielski et al. and Utsunomiya et al.

In the Office Action of July 28, 2003, claims 1, 2 and 4-6 were rejected under 35 U.S.C. §103 as being obvious in view of Bielski et al. and Utsunomiya et al. Claim 1 recites a scanning unit that includes “a voltage monitoring unit that selectively supplies said one or more individual electrical components with a voltage from said voltage source.” The Office Action has conceded that Bielski et al. does not disclose such a voltage monitoring unit. The Office Action has cited Utsunomiya et al. as overcoming the deficiencies of Bielski et al. In particular, the Office Action has asserted that it would have been obvious to use in Bielski et al. the voltage monitoring unit disclosed in the abstract and in various passages at columns 2, 3, 5 and 6 of Utsunomiya et al. Applicants traverse this proposed combination. In particular, position measuring systems as recited in claim 1 inherently dissipate power that is substantially higher than the power dissipated by low power consumption systems, such as electronic watches, portable communication instruments or electric home appliances, contemplated by Utsunomiya et al. (Col. 1, ll. 3-8). Thus, the combination would be inoperable and so there would be no suggestion to combine.

Despite the impropriety of the rejection, claim 1 has been amended to recite that

a scanning unit that includes “a voltage monitoring unit that selectively supplies said one or more individual electrical components with a voltage from said voltage source based on a calculation of an internal resistance of said voltage source.” Utsunomiya et al. does not disclose or suggest supplying a voltage based on an internal resistance calculation of the voltage source. Without such suggestion, the rejection is overcome and should be withdrawn.

2. Bielski et al., Utsunomiya et al. and Potega

Claim 3 was rejected under 35 U.S.C. §103 as being obvious in view of Bielski et al., Utsunomiya et al. and Potega. Claim 3 depends from claim 1. Potega does not overcome the deficiencies of Bielski et al. and Utsunomiya et al. with respect to claim 1 as mentioned above in Section A.1. In particular, Potega does not suggest altering Bielski et al. and Utsunomiya et al. to have Utsunomiya et al.’s voltage monitoring unit supply a voltage based on an internal resistance calculation of the voltage source. Without such suggestion or motivation, the rejection is improper and should be withdrawn.

3. Bielski et al., Utsunomiya et al. and Hoon

a. Claims 7-11

Claims 7-11 were rejected under 35 U.S.C. §103 as being obvious in view of Bielski et al., Utsunomiya et al. and Hoon. Claims 7-11 depend directly or indirectly

from claim 1. Hoon does not overcome the deficiencies of Bielski et al. with respect to claim 1 since Hoon does not suggest altering Bielski et al. and Utsunomiya et al. to have Utsunomiya et al.'s voltage monitoring unit supply a voltage based on an internal resistance calculation of the voltage source. Without such suggestion or motivation, the rejection is improper and should be withdrawn.

b. Claims 12 and 13

Claims 12 and 13 were rejected under 35 U.S.C. §103 as being obvious in view of Bielski et al., Utsunomiya et al. and Hoon. Claim 12 recites activating one or more electrical components of the scanning unit, provided a sufficient supply voltage has been determined during a check of a supply voltage. The Office Action has conceded that both Bielski et al. and Utsunomiya et al. do not disclose such activation. The Office Action has cited Hoon as overcoming the deficiencies of Bielski et al. and Utsunomiya et al. In particular, the Office Action has asserted that it would have been obvious to activate one or more electrical components of a scanning unit used in the combination Bielski et al. and Utsunomiya et al. provided a sufficient supply voltage has been determined during a check of a supply voltage as disclosed in Hoon. Applicants traverse the proposed combination of Bielski et al. and Utsunomiya et al. for the same reasons stated above in Section A.1, since the references are directed to entirely different power dissipation systems that would be rendered inoperable if combined with one another.

Despite the impropriety of the rejection, claim 12 has been canceled and claim 13 has been amended to be in independent form where the processes of 1) measuring a supply voltage of the scanning unit for a first time and 2) providing a defined load with a voltage have been deleted and recited in new claim 21. Independent claim 13 recites that the performance of the checking of the supply voltage is achieved by “calculating an internal resistance of said supply voltage.” Neither Bielski et al., Utsunomiya et al. nor Hoon disclose or suggest performing a check of a supply voltage of a scanning unit supplied by a voltage source by calculating an internal resistance of the voltage source. Without such suggestion, the rejection of claim 13 is improper and should be withdrawn.

As noted above claim 13 has been amended so as to be independent form. Since the amendments to claim 13 either incorporate subject matter that was inherently present or cancel subject matter, the amendments are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

B. Claims 14-20

Applicant notes with appreciation that claims 14-20 have been indicated to contain allowable subject matter.

C. Claim 21

New claim 21 depends directly on claim 13 and so is patentable over Bielski et al., Utsunomiya et al. and Hoon for at least the same reasons given above in Section A.3.b.

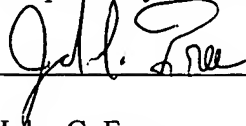
Since claim 21 is being presented to provide additional coverage for the method of claim 13, it is not related to patentability as defined in *Festo*.

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-11 and 13-21 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any

remaining issues, he is respectfully requested to contact the undersigned attorneys at
(312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

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